

(D) REMARKS, including DRAWING AMENDMENTS, if any

The Examiner has cited the applicants own paper "eFlow: a Platform for Developing and Managing Composite e-Services," HPL-2000-36, March 2000 (hereinafter "HPL paper"), as anticipating the present invention. Applicants who co-authored the cited reference respectfully disagree with the interpretation of it as proffered by the Office.

It is axiomatic that claims are not to be interpreted in a vacuum. Slimfold Mfg. Co. v. Kinthead Indus., 810 F.2d 1113, 1 USPQ 2d 1563 (Fed. Cir. 1987); Moleculon Res. Corp. v. CBS, Inc., 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986). The claim and specification language must be considered. DMI, Inc. v. Deere & Co., 755 F.2d 1570, 225 USPQ 236 (Fed. Cir. 1985). By ignoring the present application's use of the claims limitations as discussed in the Detailed Description, the argument as set forth in the Action ignores this requirement. Understanding, or Interpreting, a limitation *already in a claim* in light of the Detailed Description is not the same as an impermissible reading of a limitation into a claim. Otherwise, these court decisions are rendered meaningless. This need for consideration of "specification language" is particularly applicable in computer process cases where terms carry a special rather than ordinary (dictionary) meaning.

Generally speaking, there are at least two aspects of the present invention as set forth in the Detailed Description and the claims of the application that are neither proposed nor shown in the earlier HPL paper by inventor Casati et al. The latter is a discussion of a type of "workflow" for segregated e-services as described in the Background section of the application; see e.g., specification pp. 5-6. The present invention in one of its basic aspects comprises a novel, non-obvious, *composition e-service*. That is, in general the present invention relates to a *new e-service* that *receives or consumes a specification of composite e-services* and thus creates a new composite e-service for the end user. In other words, there is novelty in the service composition model, including in particular the notion of service nodes, method nodes, and the related attributes and semantics that enable considerable simplification of the service modeling and development phase. Thus, in its specifics, the described and claimed present invention includes such "service nodes" and "method nodes," again, not found in the earlier HPL paper.

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Amendment A

1 Therefore, the present invention is both substantively different from the HPL paper methodology  
2 and substantial improvement over the state of the art described in both the Background section  
3 of the specification and the HPL paper and the described "eFlow" technology. For this reason  
4 alone, all the rejections should be withdrawn.

5 However, in order to further prosecution, examples of differences between the cited  
6 author/inventor's referenced HPL paper and certain aspects of the claims are stated more  
7 specifically below. It should be understood that the claims, particularly independent claims, may  
8 contain one or more of the specific differences described.

9 With respect to amended claim 1, incorporating claim 2, and to claims 3, 13-18, and 24, 25,  
10 28 (independent), 29 (independent), 36, 37 (independent), "method nodes" are not mentioned in  
11 the HPL paper, and with respect to claim 33 wherein it says "...*expansion* of each of said  
12 generic electronic service *into said operations*...". One of the main points of the invention, such  
13 as described at pages 23 and 32 to the specification, is the concept of having service nodes  
14 with "executable operations inherent..." that are then expanded into the claimed "method  
15 nodes." This expansion is therefore an invocation of methods from an e-service node into the  
16 described and claimed new "model." The HPL paper only shows, for example, high level  
17 available services. See e.g., FIG. 4 where each and every box is a service, not inherent  
18 "executable operations" nor "method nodes."

19 Only claims 1, 23, 28, 29, 33, and 37 are independent claims. A dependent claim includes all  
20 the limitations of the claim from which it depends and, as such, makes specific that which was  
21 general. 35 U.S.C. 112; 37 C.F.R. Sec. 1.75(c); Allen Group, Inc. V. Nu-Star, Inc., 197 USPQ  
22 849 (7th Cir. 1978); Ex parte Hansen, 99 USPQ 319 (Pat. Off. Bd. App. 1953). Dependent  
23 claims are non-obvious if the independent claims from which they depend are non-obvious. In  
24 re Fine, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988); see a/so Hartness International, Inc. V.  
25 Simplimatic Engineering Co., 2 USPQ2d 1826, 1831 (Fed. Cir. (1987) to the same effect re  
26 novelty). Thus, allowance of a base claim as patentable normally results in allowance of a claim  
27 dependent upon that claim. The description of each dependent claim hereinafter is intended  
28 therefore to include previously described limitations.

1 Even more specifically, with respect to **claim 3**, the argument offered by the Office is a  
2 misunderstanding of the HPL paper and the present invention. The HPL paper describes  
3 process templates and subprocesses commonly referred to in the art as “code reuse.” The  
4 present application defines as one key feature of the invention a distinction between service  
5 nodes and method nodes; see specification pages 23 and 32 et seq. The HPL paper simply  
6 does not show as in claim 3: “service nodes ... expandable into a second flow diagram of  
7 method nodes.”

8 With respect to **claim 4**, “wherein each of said service nodes is executed by accessing an  
9 electronic service registered on an electronic service platform,” and likewise **claims 13, 26 and**  
10 **29**, while in the HPL paper at page 341 (right col.) there is a generic statement about “service  
11 composition,” the present application enables a specific kind of element, the “service nodes”  
12 having specific attributes, e.g., “*executed by accessing* an electronic service *registered* on an  
13 electronic service platform.” Again, the Detailed Description sets forth such enabling processing  
14 semantics of service node parameters and decomposition into method nodes nowhere found in  
15 the HPL paper.

16 With respect to **claim 5**, FIGURE 7 makes no reference to the aspect of service nodes that  
17 contain as part of their definition “consumer service-level properties” which *are processed at the*  
18 *present applications described meta-service e-service, referred to as Composition E-Service*  
19 *(“C’S”).*

20 With respect to **claim 6**, “wherein said consumer service-level properties comprises:  
21 a service search recipe or service selection rule,” and the present application’s Detail  
22 Description of selecting a specific service that corresponds to a specific description, namely, the  
23 “service search recipe or service selection rule,” it is clear that no such elements are shown in  
24 FIGURE 7 of the HPL paper. Said FIGURE 7 merely shows replacing generic boxes/nodes with  
25 process fragments. This happens at process instantiation time, having nothing to do with  
26 resolving “service nodes” with actual services as taught in the present application.

1 With respect to claim 7, "wherein said consumer service-level properties comprises: a service  
2 reuse," the HPL paper describes a different type of "reuse." The HPL paper merely describes  
3 reusing business logic - - process templates - - to simplify process development. The present  
4 application describes and claims referencing the same service for multiple method invocations.  
5 It can not be over-emphasized that one must understand and interpret a claim in view of the  
6 specification; to understand and interpret limitations *already in a claim* in light of the Detailed  
7 Description is not the same as an impermissible reading of a limitation into a claim.

8 With respect to claims 8-12, "wherein said consumer service-level properties comprises:...",  
9 and also to the same effect claims 27, 28, 34, 35 there is again no disclosure in FIGURE 1 or  
10 elsewhere as cited by the Office to the concept of a *service composition* model that includes the  
11 notion of service nodes that can be *further refined into method nodes having the defined*  
12 *characteristics* as set forth in the present application. FIGURE 1 of the HPL paper merely  
13 shows a company offering several services. The present application and claims define a new e-  
14 service which is a newly formed composition from e-service nodes.

15 With respect to dependent claims 19, 20-22, and 30, 31, 38 these limitations are clearly defined  
16 and understood options. In PSC Computing Products, Inc. v. FoxComm International, Inc., Fed.  
17 Cir., No. 03-1089, 01/20/04, the court held that disclosed but unclaimed subject matter is  
18 dedicated to the public if it is sufficiently specific to be understood and identified by one of  
19 ordinary skill in the art.. Also citing Johnson & Johnston Assoc. v. R.E. Service Co., 285 F.3d  
20 1046 (Fed. Cir. 2002, en banc). This apparently requires applicants to now claim every detail if  
21 when combined with novel, non-obvious elements of prior claims there is a remote possibility it  
22 might otherwise be interpreted of dedication to the public. Relating to the specific claims  
23 objected to by the Office, while terms of art are employed, such combinations are claimed by  
24 law and should be allowed because a dependent claim includes all the limitations of the claim  
25 from which it depends and, as such, makes specific that which was general. See, 35 U.S.C.  
26 112; 37 C.F.R. Sec. 1.75(c); Allen Group, Inc. V. Nu-Star, Inc., 197 USPQ 849 (7th Cir. 1978);  
27 Ex parte Hansen, 99 USPQ 319 (Pat. Off. Bd. App. 1953). Dependent claims are non-obvious if  
28 the independent claims from which they depend are non-obvious. In re Fine, 5 USPQ2d 1596,  
29 1600 (Fed. Cir. 1988); see also Hartness International, Inc. V. Simplimatic Engineering Co., 2

1 USPQ2d 1826, 1831 (Fed. Cir. (1987) to the same effect re novelty). While claim 32 also may  
2 fall into this category, it should be noted that the further limitation of claim 31 regarding  
3 "executing the hierarchical specification" derived for the composite e-service is yet another  
4 distinction. See also applicants' general arguments and those re claims 8 et al., supra.

5 With respect to independent claim 23, again, as generally discussed at the beginning of these  
6 Remarks, the HPL paper is not describing "a composite service forming a generically defined  
7 flow for said process." and "wherein each of said service nodes is representative of a  
8 respective service invocation setup phase for each of the individual services." There is simply  
9 no enabling information in the HPL Paper regarding "service invocation setup phase for each of  
10 the individual services." See also applicants' argument re claim 1, supra.

11 It seems to the applicants that the Office is reading into the HPL paper elements of the  
12 application based on hindsight using the application as the template. Hindsight reasoning using  
13 the invention for which a patent is sought as a template is impermissible. Texas Instruments,  
14 Inc. v. ITC, 26 USPQ2d 1018 (CA FC 1993).

15 Based upon the foregoing, it is submitted that the application now presents claims which are  
16 directed to novel, unobvious and distinct features of the present invention which are an  
17 advancement to the state of the art. Reconsideration and early allowance of all claims is  
18 respectfully requested. The right is expressly reserved to reassert any and all arguments,  
19 including the raising of new arguments, should a Notice of Allowance not be forthcoming.

1 Questions or suggestions that will advance the case to allowance may be directed to the  
2 undersigned by teleconference at the Examiner's convenience.

3 Date: July 21, 2004  
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Respectfully submitted,  
Hewlett-Packard Company



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